

-- REMARKS --

The present amendment replies to a Non-Final Office Action dated July 3, 2006. Claims 1-7 are pending in the present application. In the Non-Final Office Action, the Examiner rejected pending claims 1-7 on various grounds. Claims 1 and 3-7 are amended, claim 2 is cancelled, and claims 8-15 are added herein. The Applicants respond to each ground of rejection as subsequently recited herein and respectfully request reconsideration of the present application.

Claim Objections

Claim 7 was objected to for the informality of omitting "measured." Claim 7 has been amended herein to correct the typographical error.

35 U.S.C. §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102(a or e) rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. The Applicants respectfully assert that the cited reference fails to do so.

- A. Claims 1-2 and 4-7 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,633,051 to Holloway, *et al.* (the *Holloway* patent).

The Applicants respectfully assert that the *Holloway* patent fails to teach or suggest all the claim limitations. The *Holloway* patent fail to disclose, teach, or suggest a coordinate measuring device including a probe wherein said supporting element (25) and said connection element (26) are positioned substantially adjacent to and parallel with each other without touching each other, as recited in independent claims 1 and 7.

At most, the *Holloway* patent discloses a surface sensing device with optical sensor including a stylus carrier 30 made in the shape of a trumpet fitted with a hollow stylus 32 having a workpiece contacting tip 36 at its free end. An optical transducer system is provided within the stylus assembly and comprises a fixed light source which directs a beam of light towards a stylus tip, and a retro-reflective component at the tip which reflects the beam back to a fixed detector. *See* Abstract; Fig. 2; column 3, lines 43-58.

Claims 4-7 depend directly or indirectly from independent claim 1 and so include all the elements and limitations of independent claim 1. The Applicants therefore respectfully submit that dependent claims 4-7 are allowable over the *Holloway* patent for at least the same reasons as set forth above with respect to independent claim 1.

Regarding claim 6, the Applicants respectfully assert that the *Holloway* patent fails to disclose the supporting element (25) as well as the connection element (26) includes a bend as claimed, contrary to the Examiner's conclusion. The Examiner equated the stylus carrier 30 of the *Holloway* patent with the supporting element (25) of the Applicants' invention. The *Holloway* patent discloses that any bending of the stylus carrier will be relatively insignificant. *See* column 3, lines 65-67.

Withdrawal of the rejection of claims 1 and 4-7 under 35 U.S.C. §102(e) as being anticipated by the *Holloway* patent is respectfully requested.

35 U.S.C. §103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Non-Finally, the prior art references when combined must teach or suggest all the claim limitations.

See MPEP 2143. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP 2143.03. The Applicants respectfully assert that the cited references fail to teach or suggest all the claim limitations.

- B.** Claim 3 was rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,633,051 to Holloway, *et al.* (the *Holloway* patent).

The Applicants respectfully assert that the *Holloway* patent fails to teach or suggest all the claim limitations. The *Holloway* patent fail to disclose, teach, or suggest a coordinate measuring device including a probe wherein said supporting element (25) and said connection element (26) are positioned substantially adjacent to and parallel with each other without touching each other, as discussed above for independent claim 1. Claim 3 depends directly from independent claim 1 and so includes all the elements and limitations of independent claim 1. The Applicants therefore respectfully submit that dependent claims 2-9 are allowable over the *Holloway* patent for at least the same reasons as set forth above with respect to independent claim 1.

Withdrawal of the rejection of claim 3 under 35 U.S.C. §103(a) as being obvious over the *Holloway* patent is respectfully requested.

Added Claims

Claims 8-15 have been added herein to more particularly point out and distinctly claim the Applicants' invention. Claims 8-15 are allowable over the cited reference for at least the reasons discussed above for their respective independent claim 1. No new matter has been added with the addition of claims 8-15, which are supported by Figures 3-7 and associated text in the specification.

SUMMARY

Reconsideration of 1 and 3-7 and consideration of claims 8-15 is respectfully requested in light of the remarks herein. The Applicants submit that claims 1, 3-7, and 8-15 fully satisfy the requirements of 35 U.S.C. §§102, 103, and 112. In view of foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,

CARDINAL LAW GROUP
1603 Orrington Avenue, Suite 2000
Evanston, IL 60201
(847) 905-7111

/FRANK C. NICHOLAS/
FRANK C. NICHOLAS
Registration No. (33,983)
Attorney for Applicants